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DOCKET NO.: HENK-0046

PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Konrad Scholz

Application No.: 09/877,372

Filing Date: June 8, 2001

For: Pressure Element For An Edge Gluing Machine And Gluing Method

Confirmation No.: 2436

Group Art Unit: 1733

Examiner: Jessica Rossi

DATE OF DEPOSIT: *May 5, 2004*

I HEREBY CERTIFY THAT THIS PAPER IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL, POSTAGE PREPAID, ON THE DATE INDICATED ABOVE AND IS ADDRESSED TO THE COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VA 22313-1450.

Scott E. Scioli

TYPED NAME: Scott E. Scioli
REGISTRATION NO.: 47,930

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION FOR WITHDRAWAL OF ABANDONMENT

Applicant petitions that the abandonment set forth in the notice mailed by the Office on April 6, 2004 be withdrawn as there is no abandonment in fact.

Submitted herewith is:

- ☒ A copy of the postcard identifying the papers filed and showing the U.S. PTO receipt stamp dated April 1, 2004.
- ☒ A copy of the complete response timely filed.
- ☒ A copy of Express Mail Label No. EL 969189209US which is the number identified on the first page of the previously filed response showing a written "date in" of April 1, 2004.
- ☒ Applicants authorize the Commissioner to charge Deposit Account No. 23-3050 in the amount of the petition fee. However, as no defect exists in

applicant's previous submission, an immediate refund of the petition fee is requested.

- ☒ The Commission is hereby authorized to charge payment of the above fees associated with this communication or credit any overpayment to Deposit Account No. 23-3050. This sheet is attached in duplicate.

Date: *May 5, 2004*

Scott E. Scioli

Scott E. Scioli

Registration No. 47,930

Woodcock Washburn LLP
One Liberty Place - 46th Floor
Philadelphia PA 19103
Telephone: (215) 568-3100
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Paper: Request for Continued Examination (RCE) Transmittal Pursuant to 37 CFR §1.114 (in duplicate) with Express Mail sticker (pages 1-3); Reply Pursuant to 37 CFR § 1.116 (pages 1-10); a check in the amount of \$942.00 for RCE fee and 2 additional claims; return postcard; all via Express Mail No. EL 969189209 US

Applicant(s):

Konrad Scholz Pestervitz

Title: Pressure Element For An Edge Gluing Machine And Gluing Method

Application No.: 09/877,372

Filed:

June 8, 2001

Docket No.:

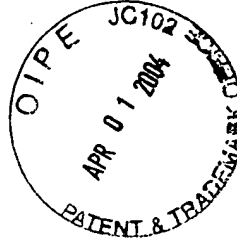
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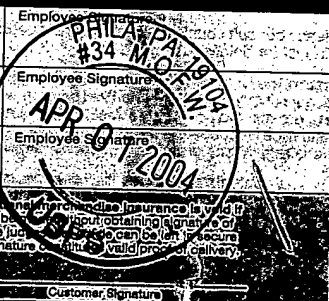
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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

COPY

In Re Application of:

Konrad Scholz Pesterwitz

Application No.: 09/877,372

Filing Date: June 8, 2001

For: Pressure Element For An Edge Gluing Machine And Gluing Method

Confirmation No.: 2436

Group Art Unit: 1733

Examiner: Jessica Rossi

EXPRESS MAIL LABEL NO: EL 969189209 US
DATE OF DEPOSIT: April 1, 2004

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Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

**REQUEST FOR CONTINUED EXAMINATION (RCE) TRANSMITTAL PURSUANT
TO 37 CFR § 1.114**

This is a Request for Continued Examination (RCE) under 37 CFR § 1.114 of the
above-identified application.

1. Submission required under 37 CFR § 1.114

☐ Previously submitted

☐ Consider the amendment(s)/reply under 37 CFR § 1.116 previously
filed on . (Any unentered amendment(s) referred to above will
be entered).

☐ Consider the arguments in the Appeal Brief or Reply Brief previously
filed on .

☐ Other: .

☒ Enclosed

- ☒ Amendment/Reply under 37 CFR § 1.116
- ☐ Affidavit(s)/Declaration(s)
- ☐ Information Disclosure Statement (IDS)
- ☐ Other:

2. Miscellaneous

- ☐ Suspension of action on the above-identified application is requested under 37 CFR §1.103(c) for a period of _____ months. (Period of suspension shall not exceed three (3) months; Fee under 37 CFR §1.17(i) required)

FEE CALCULATION:

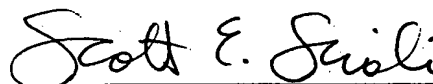
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<input checked="" type="checkbox"/> RCE BASIC FILING FEE				\$385.00	\$	\$770.00	\$770.00
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TOTAL CLAIMS	15	20 (20 MINIMUM)	0	\$9 EACH	\$	\$18 EACH	\$0.00
INDEP. CLAIMS	5	3 (3 MINIMUM)	2	\$43 EACH	\$	\$86 EACH	\$172.00
FIRST PRESENTATION OF MULTIPLE DEPENDENT				\$145	\$	\$290	\$0.00
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<input type="checkbox"/> FOUR MONTH EXTENSION OF TIME				\$740	\$	\$1480	\$0.00
<input type="checkbox"/> FIVE MONTH EXTENSION OF TIME (May only be taken when filing RCE in lieu of Appeal Brief)				\$1005	\$	\$2010	\$0.00
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<input type="checkbox"/> TERMINAL DISCLAIMER				\$55	\$	\$110	\$0.00
TOTAL FEE DUE					\$		\$942.00

- ☒ A check in the amount of \$942.00 is attached. Please charge any deficiency or credit any overpayment to Deposit Account No. 23-3050.
- ☐ Please charge Deposit Account No. 23-3050 in the amount of \$.00. This sheet is attached in duplicate.
- ☐ A response to the _____ dated _____ was due on _____. Petition is hereby made under 37 CFR § 1.136(a) to extend the time period for response from _____ to and through _____ comprising an extension of the shortened statutory period of _____ month(s).

- ☐ A Notice of Appeal was filed . An Appeal Brief is due on . Applicants are filing this Request for Continued Examination in lieu of this Appeal Brief. Petition is hereby made to extend the time period from to and through comprising a total extension of month(s).
- ☒ The Commissioner is hereby requested to grant an extension of time for the appropriate length of time, should one be necessary, in connection with this filing or any future filing submitted to the U.S. Patent and Trademark Office in the above-identified application during the pendency of this application. The Commissioner is further authorized to charge any fees related to any such extension of time to Deposit Account No. 23-3050. This sheet is provided in duplicate.
- ☒ The Commission is hereby authorized to charge payment of the above fees associated with this communication or credit any overpayment to Deposit Account No. 23-3050. This sheet is attached in duplicate.

SHOULD ANY DEFICIENCIES APPEAR with respect to this application, including deficiencies in payment of fees, missing parts of the application or otherwise, the United States Patent and Trademark Office is respectfully requested to promptly notify the undersigned.

Date: April 1, 2004



Scott E. Scioli
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Woodcock Washburn LLP
One Liberty Place - 46th Floor
Philadelphia PA 19103
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Facsimile: (215) 568-3439

DOCKET NO.: HENK-0046
Application No.: 09/877,372
Office Action Dated: August 4, 2003

PATENT
REPLY FILED UNDER EXPEDITED
PROCEDURE PURSUANT TO
37 CFR § 1.116



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Konrad Scholz Pesterwitz

Confirmation No.: 2436

Application No.: 09/877,372

Group Art Unit: 1733

Filing Date: June 8, 2001

Examiner: Jessica Rossi

For: **Pressure Element For An Edge Gluing Machine And Gluing Method**

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Sir:

REPLY PURSUANT TO 37 CFR § 1.116

In response to the Official Action dated August 4, 2003, reconsideration is respectfully requested in view of the amendments and/or remarks as indicated below:

- ☐ Amendments to the Specification begin on page of this paper.
- ☒ Amendments to the Claims are reflected in the listing of the claims which begins on page 2 of this paper.
- ☐ Amendments to the Drawings begin on page of this paper and include an attached replacement sheet.
- ☒ Remarks/Arguments begin on page 5 of this paper.

This listing of claims will replace all prior versions, and listings, of claims in the application.

Listing of Claims:

1. (Withdrawn) A pressure element (7) for an edge gluing machine for gluing a bandlike covering (4) or film by means of an adhesive onto a narrow face (3) of a straight or curved cross section of a board element (2) or onto a profile bar having a surface of straight or profiled cross section, wherein the pressure element (7) comprises an elastically deformable pressure face (30).

2. (Withdrawn) The pressure element of claim 1, wherein the pressure element comprises a sliding shoe (7).

3. (Withdrawn) The pressure element of claim 1, wherein the deformable pressure face comprises an elastic band.

4. (Withdrawn) The pressure element of claim 3, wherein the deformable pressure face comprises a spring-steel band (30).

5. (Currently Amended) A method for gluing a bandlike covering (4) or film onto a narrow face (3) of a board element (2) or a profile bar having a surface of straight or profiled cross section with adhesive, the covering (4) or film being pressed onto the narrow face (3) or profile bar by means of at least one pressure element (7) wherein the covering (4) or film is pressed on by means of a pressure element (7) which has an elastically deformable pressure face (30) that deformably matches and exerts uniform pressure on the shape of the narrow face (3) or of the profile bar, wherein movement of the board element or profile bar along its length, in relation to the pressure head, occurs while the covering is uniformly pressed onto the narrow face.

6. (Original) The method of claim 5, wherein the adhesive is a hot melt adhesive.

7. (Original) The method of claim 5, wherein the board element comprises chipboard, fiber board, or solid wood board.

8. (Previously Presented) The method of claim 5, wherein the deformable face comprises an elastic band.

9. (Previously Presented) The method of claim 5, wherein the deformable face comprises a spring-steel band.

10. (New) A method for uniformly adhering a bandlike covering onto a narrow face of a board element, the method comprising the steps of:

a) providing a pressure element that includes an elastically deformable pressure face that is capable of deformably matching and exerting uniform pressure on the narrow face, said pressure element having a length which is less than that of the narrow face; and

b) uniformly adhering the covering and adhesive onto the narrow face with the pressure element.

11. (New) The method of claim 10, wherein at least one of the pressure element and the board element is moving during the step b).

12. (New) The method of claim 10 wherein the pressure element has a length which is substantially shorter than that of the narrow face

13. (New) A method for uniformly adhering a film onto a narrow face of a board element or profile bar comprising the steps of:

a) bringing the narrow face into initial contact with the film, with an adhesive interposed, by contacting an entry zone of a pressure element;

b) uniformly pressing the film onto the narrow face, with the pressure element, said pressure element having an elastically deformable pressure face that deformably matches and exerts uniform pressure on the narrow face; and

c) moving at least one of the pressure head and the board element or profile bar, relative to the other, while uniformly pressing the film onto the narrow face with the pressure element, along the length of the board element or profile bar;

thereby uniformly adhering the film onto the narrow face of the board element or profile bar.

14. (New) A method for uniformly adhering a bandlike covering onto a narrow face of a board element or profile bar, the method comprising the steps of:

a) providing a pressure element that includes an elastically deformable pressure face that is capable of deformably matching and exerting uniform pressure on the narrow face; and

b) moving at least one of the pressure head and the board element or profile bar, relative to the other, while uniformly pressing the covering onto the narrow face with the pressure element, along the length of the board element or profile bar,

thereby uniformly adhering the covering onto the narrow face of the board element or profile bar.

15. (New) The method of claim 13, wherein the pressure element has a length which is substantially shorter than that of the narrow face.

REMARKS/ARGUMENTS

Status of the Prosecution:

After entry of this amendment claims 1-15 will be pending in the application. Claims 1-4 have been withdrawn, claims 5-9 are currently under examination. The claims were finally rejected in the Office Action dated August 4, 2003. A Notice of Appeal was filed on February 4, 2004. Claim 5 has been amended herein and new claims 10-15 added. Applicant submits herewith a Request for Continued Examination (RCE).

This response clarifies the Applicant's position and the amendments made herein distinguish the instant claims from the cited art. The amendments overcome the outstanding rejections and are believed to place the claims in condition for allowance.

For example, claim 5 is amended herein to point out that the method is preferably *a continual process* because the board element, and thus its narrow face and the pressure element, are in movement relative to each other, while in uniform contact with each other. The continuous nature of this edge gluing process plainly distinguishes the instant methods from the non-continuous attachment operations cited in the Office Action.

New claims 10-14 are presented herein are generally directed to methods of attaching a bandlike covering (or a film) to a narrow face of a board element (or profile bar). Support for the amendments may be found throughout the specification, for example on pages 9 and 10.

The Claims Are Not Anticipated By The Cited References.

The claims are directed to methods for attaching a covering to a profiled narrow face of a board or the like. Claim 5 is directed to methods of gluing a bandlike covering or film onto a narrow face of a board element or a profile bar with adhesive. The covering or film is pressed onto the narrow face or profile bar by means of at least one pressure element. The pressure element has an elastically deformable pressure face that deformably matches and exerts uniform pressure on the shape of the narrow face or of the profile bar. Movement of the board element or profile bar along its length occurs relative to the pressure head while the covering is pressed onto the narrow face by uniform contact with the pressure element.

Claim 5 stands rejected under 35 U.S.C. § 102 (b) as allegedly anticipated by Finke (U.S. Patent No. 4,261,783) ("Finke"). While Finke allegedly teaches a label being pressed onto a board element by means of at least one pressure element, Finke does not teach the method of claim 5 as amended. For example, Finke does not teach a method wherein the board element is moving while in uniform contact with the pressure element. Finke teaches a pressure element with annular discs portions with small projections (see Finke, figures 8-10). In particular, Finke states that these small projections 232' "provide only a small area of contact between the applicator 201 and the label 21H." The design of Finke's applicator *completely precludes maintaining uniform pressure* not only because of the space between the discs and that between the projections, but also because of the resulting intermittent contact with the small projections as the applicator rotates. Uniform pressure is not taught – it is not necessary for applying labels to boards, the intended use of Finke's applicator, and was never remotely contemplated by Finke. Finke does not anticipate the claim as amended because it does not teach each and every limitation. Applicant respectfully requests that the rejection based on Finke be withdrawn.

Similarly claims 5 and 8 stand rejected as allegedly anticipated under 35 U.S.C. § 102 (e) by La Mers (U.S. Patent No. 3,823,050) ("La Mers"). While La Mers allegedly teaches a method of applying a label to a narrow face of a board element, La Mers *necessarily* does not involve a method wherein the board element is moving *along its length, relative to the pressure element, while in uniform contact with the pressure element*. La Mers applicator head is adapted to apply labels to rounded and convex object, and it is not apparent that the skilled artisan would find it useful for applying labels to a narrow face because the La Mers applicator head is designed so that the forward ends of the columns bend inwardly towards each other so that the flexible blanket can "wrap" the label around the object. A skilled artisan seeking only to apply an edge band would not be interested in such a "wrapping" function. More importantly, La Mers specifically teaches that *sliding contact must be avoided* as it could result in frictional removal, shifting, or wrinkling of the label (See e.g. Abstract and Summary sections). La Mers simply does not teach applying the covering *to a narrow face* of a board element, as the objects shown in La Mers do not have a narrow face, or cannot be said to have a narrow face which is capable of moving while in contact with the

pressure element. Applicant respectfully requests withdrawal of the rejection based on La Mers.

Claims 5 and 8-9 stand rejected under 35 U.S.C. § 102 (e) as allegedly anticipated by Wu *et al.* (U.S. Patent No. 6,383,335). Although Wu allegedly teaches a pressure element that has a deformable face and exerts uniform pressure, it does not teach using that pressure element to glue onto the narrow face of "a board element", as defined for the instant claims. The present claims are directed to methods, and as such an anticipatory reference must teach each and every step of the method. Wu does not teach the steps of the instant claims and accordingly, the reference must be withdrawn.

In particular, Wu does not teach a method as defined in the claims, wherein the narrow face of the board is in movement relative to the pressure element, while in uniform contact with the pressure element. The only movement taught by Wu is in the heat bonding head, which moves up and down in order to make contact with the heat bonding sheet. Wu does not teach a method wherein the board element moves along its length, relative to the pressure element, while maintaining uniform contact with the pressure element. The rejection under 35 U.S.C. § 102(e) in view of Wu must be withdrawn.

The Claims are Not Obvious in View of the Cited References

Claims 5 and 7 stand rejected under § 35 U.S.C. § 103(a) as allegedly unpatentable over Finke as applied to claim 5 above, and further in view of Paulk *et al.* (U.S. Patent No: 6,529,799)("Paulk").

The Office Action relies on Finke, alleging that Finke is not limited to any particular shaped object, although it does not expressly teach board elements. The Office Action states that is known to attach adhesive labels to boards in the center, or at a corner as taught by Paulk. Paulk teaches board elements comprising chipboard, fiberboard, or solid wood.

Neither Finke nor Paulk, nor the combination thereof, can be said to teach each and every element or step of the claimed methods. Finke, as described above, does not teach any movement of a board element relative to the pressure element while maintaining uniform pressure therewith. Paulk cannot provide what Finke lacks, as it teaches only discontinuous movement of a labeling assembly within a pack of boards (see *e.g.* Fig 4 in Paulk). Paulk does not teach movement along the long axis of the board element, but rather only movement

DOCKET NO.: HENK-0046
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Office Action Dated: August 4, 2003

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37 CFR § 1.116

of the assembly in the short axis of the board element, and the short axis of the pack of boards. The labeling assembly moves only from board to board, and not down the length of each board while in uniform contact with the edge of the board.

Therefore, it would not have been obvious to the skilled artisan to combine the teachings of Finke with those of Paulk, to arrive at the claimed invention, because the combination of these two references cannot produce the claimed method. Accordingly, the *prima facie* case is insufficient and the rejection under § 35 U.S.C. § 103(a) must be withdrawn.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as allegedly not patentable over Finke in view of Schut *et al.* (US Patent No: 6,376,058) ("Schut"). The shortcomings of Finke have been discussed above. Schut does not provide the limitations needed to make instant claim 6 obvious. Although Schut teaches hot-melt adhesives for applying facestock to liner in label production, the combination of Finke and Schut does not teach all the limitations of the underlying claim, and thus does not render it obvious.

Additionally, *Schut is plainly nonanalogous art*. The examiner previously analogized application of edgebanding to boards to the application of a label to virtually any shaped item (such as bottles and IC chips). With the attempted introduction of Schut, the examiner extends this analogy to applying facestock to labels. This art is completely unrelated to the instant claims directed at applying edge-banding to the narrow face of a board, and does nothing to advance the examiner's *prima facie* case.

The art is nonanalogous because no skilled artisan seeking to solve the problem of uniformly gluing an edgeband to a board would ever consider Schut, which relates to applying facestock to a label. There is no hint or suggestion to combine these references, and in any case, the instant methods relate to problems regarding applying a band to the narrow edge, not the face, of a board. The skilled artisan would recognize that applying facestock in no way entails the same problems as applying edge banding. The operational and mechanical difficulties encountered are completely different. Thus, in addition to not providing the elements or steps missing from Finke, Schut is of absolutely no interest to the artisan trying to arrive at the instant methods. The *prima facie* case is insufficient, and the rejection under 35 U.S.C. § 103(a) must be withdrawn.

Claims 5 and 7 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over La Mers, and further in view of Paulk. The Office Action alleges that La Mers shows a board element or profile bar in figure 10, and that the reference is not limited to any particular object shape. The Office Action alleges that it would have been obvious to apply the label of La Mers to a board element as taught by Paulk. Neither La Mers, nor Paulk, nor the combination thereof, teach the limitations of the methods of claims 5 or 7. In particular, as discussed above, La Mers teaches *only* a necessarily discontinuous process in which sliding must be avoided. Nothing in either La Mers or Paulk even remotely suggests that the process of applying labels could be used to apply a label on the narrow edge of a board element along its entire length. More particularly these reference do not suggest that such a process could be done continuously, while maintaining uniform contact with the pressure element. Paulk cannot provide the missing limitations because Paulk teaches only movement across the edge of the board element, and the pack of boards, i.e. the labeling assembly moves from board to board, and not down the length of each board while in uniform contact with the edge of the board. The combination of the references does not teach the limitations of the instant claims and cannot negate patentability. Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 103(a).

Claim 6 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over La Mers and further in view of Schut. As discussed above, Applicants regard Schut as plainly nonanalogous art. In any case, the skilled artisan seeking to arrive at the invention of claim 6 would not be motivated to combine La Mers and Schut, and such a combination would not result in the claimed method. For the reasons discussed above, the *prima facie* case of La Mers in view of Schut does not provide each and every limitation of the instant claims. La Mers does not teach a method for application of a edge band to the narrow face of a board element while maintaining uniform contact with the pressure element. Because the combination of the references does not teach the limitations of the instant claims, the *prima facie* case is rebutted. Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 103(a).

Claim 9 stands rejected under 35 U.S.C. § 103 (a) as allegedly unpatentable over La Mers as applied to claim 5 above, and further in view of Wu. As discussed above, La Mers teaches only a necessarily discontinuous application of a label to an abject lacking a narrow

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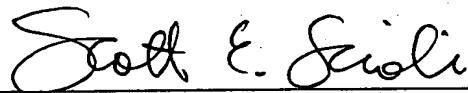
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37 CFR § 1.116

face, and does not teach the movement of the object. For purposes of obviousness, Wu, like Schut is nonanalogous art for the purposes of 35 U.S.C. § 103 (a). The skilled artisan seeking to solve the problem of developing a continuous process for applying an edge band or film to the narrow face of a board element or profile bar would not consult Wu which addresses manufacturing a an ink-jet printhead. Even if, for the sake of argument, the skilled artisan were to consider Wu, as set forth above, the only movement taught by Wu is in the heat bonding head, which moves up and down in order to make contact with the heat bonding sheet. Wu would not be considered, but it is clear that even if it were considered, Wu cannot be combined with La Mers to arrive at each limitation or step of the methods claimed by the Applicant. Applicants respectfully assert that the combination of La Mers and Wu does not constitute a *prima facie* case for the foregoing reasons, and the rejection must be withdrawn.

Conclusion:

The amendments and remarks herein are believed to be fully responsive to the Office Action. Applicant respectfully asserts that all claims are now in condition for allowance. An early and favorable Notice to that end is earnestly solicited. To resolve any outstanding issues prior to allowance of the claims, the Examiner is invited to contact the Applicant's undersigned representative by email at sscioli@woodcock.com, by telephone at 215-557-5986 or by facsimile at 215-568-3439.

Respectfully submitted,



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